UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,715	11/09/2001	Chandrashekhar P. Pathak	2962.16US01	4146

24113 7590 01/12/2005

PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

EXAMINER	
MOHAMED, ABDEL A	

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application N .	Applicant(s)	
	10/010,715	PATHAK ET AL.	
	Examiner	Art Unit	
	Abdel A. Mohamed	1653	

--The MAILING DATE of this communication appears on the cover she t with the correspondence address --

THE REPLY FILED 20 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-35*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

JON WEBER
SUPERVISORY PATENT EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: The rejection under 35 U.S.C. 103(a) over the prior art of record is maintained for the reasons set forth in the previous Office action. It is noted that Applicant has amended claims 1, 21, 24 and 25 for clarity with respect to the term visualization agent. Applicant has argued that the primary reference of Hubbell et al does not supply the claimed visualization element because as supported by the enclosed article of Gruber et al which states that a photoinitiator "can be defined as a molecule which absorbs energy, either directly or indirectly, from a photon and subsequently initiates photopolymerization. The [photoinitiator] is consumed during the process". Since the photoinitiator is consumed, it is not present after the gel is formed. Therefore, Hubbell et al does not supply the claimed visualization element and there can be no prima facie case of obviousness. Contrary to Applicant's arguments, the primary reference of Hubbell et al teaches the use of photoinitiators and/or catalysts which are dispersed with the polymerized hydrogels. Thus, the primary reference clearly provides the claimed element of a visualization agent (e.g., methylene blue). Further, the enclosed articles provided by Applicant have been considered, however, contrary to Applicant's assertion, 'catalyst" by definitation is not consumed. Therefore, the combined teachings of the prior art makes obvious the claimed invention for the reasons of record. With respect to obviousness type double patenting rejection of the present claims in light of U.S. Patent No. 6,566,406, it is noted that Applicant is prepared to promptly provide terminal disclaimer over U.S. Patent No. 6,566,406 if the present claims are indicated to be otherwise allowable. However, since no claim is allowed, the rejection of obviousness type double patenting is maintained for the reasons of record.